

## REMARKS

Claims 1-64 are pending in the present application. Claims 61-64 were added in the Amendment filed on November 20, 2003. But the Office Action did not address claims 61-63. Applicants request that claims 61-63 be examined on the merits along with claims 1-60.

The amendments to claims 25-28 and 50-64 are supported by the specification at page 4, line 6, page 5, lines 5-27, page 6, lines 9-10, and page 9, lines 16-18.

The amendments to claims 1, 19, 23, 25-28, 36, 37 and 50-64 are cosmetic and should not narrow the scope of the amended claim recitations. For instance, the replacement of “wherein R<sub>1</sub>, through R<sub>4</sub>” under formula B in claim 1 with “wherein R<sub>1</sub> through R<sub>4</sub>” is done for grammatical purposes. Furthermore, the amendment to claim 37 should not narrow the scope of the amended claim recitation because it would have been apparent to a person skilled in the art that “the phase transfer catalyst” in claim 37 refers to “a phase transfer catalyst” in claim 36, so claim 37 should depend on claim 36 instead of claim 29.

Applicants thank the Examiner for allowing claims 2-15, 19, 21, 24 and 29-60.

### Rejection of Claims Under 35 U.S.C. § 112, Second Paragraph

A. Claims 16-18, 22, 51 and 52 were rejected as indefinite because of the trademark “OXONE.” Applicants respectfully traverse the rejection.

MPEP 608.01 (v) provides:

Names used in trade are permissible in patent application if:

- (a) their meanings are established by an accompanying definition which is sufficiently precise and definite to be made a part of a claim; or
- (b) in this country, their meanings are well-known and satisfactorily defined in the literature.

In the specification, OXONE is disclosed to be “a trademark name of an oxidizing agent under Du Pont for an acidic, white, granular, free-flowing solid containing the active ingredient potassium peroxymonosulfate” (page 6, lines 5-7). With the source, characteristics and active ingredient of OXONE disclosed in the specification, applicants submit that the term “OXONE” is accompanied by a definition which is sufficiently precise and definite to a person skilled in the

art to be made a part of a claim. For instance, claim 24 of U.S. Patent No. 4,975,109 and claim 16 of U.S. Patent No. 6,143,909, both of which patents were issued before the filing date of the instant application, recite the term "OXONE" or "Oxone" (see copies attached to the Amendment of November 20, 2003).

Alternatively, applicants submit that, in the United States, the meaning of "OXONE" is well-known as evidenced by its definition in *The Condensed Chemical Dictionary*, 1966, Reinhold Publishing Corp., New York (see the copy attached to the Amendment of November 20, 2003). According to this dictionary, "OXONE" is defined as a trademark "for an acidic, white, granular, free-flowing solid containing the active ingredient potassium peroxymonosulfate."

As a result, withdrawal of the indefiniteness rejection is requested.

B. Claims 25-28 were rejected as indefinite because the Examiner alleged that it was not clear if a compound or composition was being claimed. Applicants respectfully traverse the rejection. Each of claims 25-28 is drawn to a drug, i.e. omeprazole, lansoprazole, pantoprazole or rabeprazole, in the format of a product-by-process claim. It is well known in the art that products prepared by chemical processes may contain by-products. Applicants are entitled to claim a product prepared by a chemical process containing less than a specific amount of a by-product. Applicants submit that claims 25-28 are not indefinite because it is clear to a person skilled in the art that each of the drugs being claimed contains less than about 4.5% of a sulfone by-product. Applicants request that the rejections of claims 25-28 be withdrawn.

## CONCLUSION

In view of the above reasoning, applicants respectfully submit that all the claims are allowable. A Notice of Allowance is believed in order.

In the event that the filing of this Amendment is deemed not timely, applicants petition for an appropriate extension of time. The petition fee, and any other fees that may be required in relation to this paper, can be charged to Deposit Account No. 11-0600.

Respectfully submitted,

KENYON & KENYON

Dated: June 15, 2004

By: King L. Wong  
King L. Wong, Ph.D.  
Reg. No. 37,500

1500 K Street, N.W., #700  
Washington, DC 20005-1257

495653\_1